REMARKS

After entry of the above amendments, the claims pending in the subject application are 8, 12-16, and 20-23. Reconsideration of this application based on the Amendments and Remarks presented herein is respectfully requested.

Section headers have been added to the specification as requested.

35 U.S.C. §102 REJECTIONS

Claims 8, 15, 16, and 23 were rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 4,134,866 to Tominaga et al.

Claims 8, 15, 16, and 23 were rejected under 35 U.S.C. §102(e) as being anticipated by United States Patent No. 6,146,512 to Hoefer et al.

These rejections are rendered moot with the amendment of claim 8 to contain at least one limitation from previous claims 9, 10, and/or 11.

35 U.S.C. §103 REJECTIONS

Claims 9-14 and 17-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 4,134,866 to Tominaga et al.

Claims 9-14 and 17-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 6,146,512 to Hoefer et al.

In both rejections, it was alleged that the selection of any known equivalent polyvinyl alcohol would have been obvious (as to claims 9-11 or 17-19). "In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents" (MPEP 2144.06). "Expedients which are functionally equivalent to each other are not necessarily obvious in view of one another." In re Scott, 139 USPQ 297, 299 (CCPA 1958).

In order to support a prima facie case of obviousness based on what is common knowledge to one of ordinary skill in the art, the facts relied upon must be supported by concrete evidence. In In re Zurko, 258 F.3d 1379 at 1386, 59 U.S.P.Q. 2d. 1693 at 1697 (Fed. Cir. 2001), the court stated

> With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience--or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.

Also, in In re Sang Su Lee, No. 00-1158 (Fed. Cir., decided January 18, 2002), the court further stated

> The Board's finding must extend to all material facts and must be documented on the record, lest "the haze of so-called expertise" acquire insulation from accountability. "Common knowledge and common sense," even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority. Citing Allentown Mack Sales and Service, Inc. v. National Labor Relations Bd., 522 U.S. 359, 376 (1998) ("Because reasoned decision making demands it, and because the systemic consequences of any other approach are unacceptable, the Board must be required to apply in fact the clearly understood legal standards that it enunciates in principle . . .")

The case law specifically requires factual evidence to support a finding.

There is no evidence of record to indicate that the prior art recognizes the claimed polyvinyl alcohol (co)polymer is an equivalent to a polyvinyl alcohol polymer disclosed in Tominaga '866 or Hoefer '512. Therefore, it is respectfully submitted that claims 8, 12-16, and 20-23 are patentable over United States Patent No. 4,134,866 to Tominaga et al. and that claims 8, 12-16, and 20-23 are patentable over United States Patent No. 6,146,512 to Hoefer et al.

In view of the amendments and remarks contained above, Applicants respectfully request reconsideration of the application, withdrawal of the 35 USC §102 and §103 rejections, and request that a Formal Notice of Allowance be issued for claims 8, 12-16, and 20-23. Should the Examiner have any questions about the above remarks, the undersigned attorney would welcome a telephone call.

Respectfully submitted,

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